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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,451	04/24/2001	Kuniaki Kawamura	199/49908	1890

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EXAMINER	
BORISSOV, IGOR N	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/840,451	KAWAMURA ET AL.	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13. The phrase "a plurality of at least one" is confusing. The term "plurality" implies more than one, which contradicts with "at least one" statement.

The remaining claims are rejected as being dependent on claim 13.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nierlich et al. (US 2003/0158632) (Nierlich) in view of Grinblat (US 4,902,322) and further in view of Houlihan (US 5,351,712).

Nierlich teaches a method and system for monitoring and controlling energy distribution, comprising:

Claim 1. An energy management system comprising means for monitoring energy consumed by the user (including HVAC units) over the Internet, wherein the

user is notified about power curtailment events in accordance with the variation of the load, and wherein the power curtailment events include providing a listing of load reduction/displacement items including HVAC units, said load reduction /displacement is conducted when user load is reaching a predetermined projected level [0037]; [0066]; [0074].

Nierlich does not specifically teach that the power curtailment events include installing additional portable heating or cooling unit (hereafter referred to as unit) or reducing the number of existing units in accordance with the variation of the heat/cold heat load.

Grinblat teaches a method and system for supplemental air conditioning units for building, wherein a tenant who requires a lower temperature in his premises may install the supplemental unit (column 4, lines 64-68). However, Grinblat does not specifically teach that said unit is a portable unit.

Houlihan teach a hot water recovery method and apparatus, wherein said apparatus may be implemented as a portable unit, and may be temporarily installed by lessees or leased structures who desire reduce utility costs by saving energy consumption (column 14, lines 7-11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nierlich to include that the power curtailment events include installing additional heating or cooling units, as disclosed in Grinblat, because it would advantageously allow to solve the local environmental needs of individual tenants without costly renovating of whole building heating system, thereby saving funds. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nierlich in view of Grinblat to include that said unit is a portable unit, as disclosed in Houlihan, because it would advantageously simplify the installation processes of this unit, therefore decrease costs associated with it.

Claim 15. Nierlich teaches said method and system, in which the user is charged for the energy used and wherein charges reflect fluctuating power usage [0066].

Claims 16 and 17. Same reasoning as in claim 1.

Claim 18. Nierlich et al. teach said method and system, comprising providing a network (the Internet) and servers for circuitry monitoring, and monitoring data related to the amount of power used in order to effect power curtailment events, wherein said data is shared over the Internet [0037]; [0046]; [0049]; [0085].

Claim 18. See **claim 1.**

Remarks

The examiner respectfully submits that applicants' arguments and comments do not appear to traverse what examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Response to Arguments

Applicant's arguments filed 6/17/2004 have been fully considered but they are not persuasive.

In response to the applicant's argument that the prior art does not teach *optimizing energy efficient supply of heating and cooling*, it is noted that the "*optimizing*" feature upon which applicant relies in claims 13-19 is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no suggestion to combine Nierlich and Grinblat, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to monitoring HVAC type equipment, wherein the cost of energy used is under control. The motivation to modify Nierlich to include that the power curtailment events comprise installing additional heating or cooling units as disclosed in Grinblat would be ability to solve the local environmental needs of individual tenants without costly renovating of whole building heating system.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB

8/28/2004

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600